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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,992	06/24/2003	Beverly Jean El A'mma	A01376	1607

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT PAPER NUMBER

1614

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,992

Applicant(s)

EL A'MMA ET AL.

Examiner

Cybille Delacroix-Muirheid

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Detailed Action

The following is responsive to applicant's amendment received Jan. 12, 2005.

Claim 4 is cancelled. No new claims are added. Claims 1-3, 5-10 are currently pending.

The previous rejection of claim 5 under 35 USC 112, second paragraph, set forth in paragraph 1 of the office action mailed Sep. 13, 2004, is withdrawn in view of applicant's amendment and the remarks contained therein.

The rejection of claim 9 under 35 USC 103(a) is withdrawn in view of applicant's amendment and the remarks contained therein. Unexpected results are provided in the specification at page 10, lines 9-15 and Table 2.

However, applicant's arguments traversing the previous of claims 1-3, 5-8,10 under 35 USC 103(a) set forth in paragraph 2 of the office action mailed Sep. 13, 2004 have been considered but are not found to be persuasive.

Applicant argues that the claimed compositions, unlike the solvent-based compositions of Gaglani, are aqueous compositions requiring 40-99 percent water. There is no disclosure, teaching or suggestion in Gaglani that addition of a chelating agent will be effective to stabilize haloalkynyl compounds, which are unstable in aqueous compositions. Additionally, applicant states the compositions disclosed in Gaglani are of a biocide plus chelating agent which is subsequently added to the alkyd formulation containing a transition metal drier or for compositions in which the chelating agent is added to the alkyd formulation containing the transition metal drier plus biocide. (See col. 6, lines 40-42 and 49-56).

However, applicant's compositions require that the metal ion be added to the composition already in the form of a chelated ion. Applicant has discovered that there is a significant

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difference between adding an already complexed metal to the composition compared with adding the metal ion and the complexing agent separately. Unexpected results are demonstrated in applicant's specification page 10, lines 9-15 and Table 2, particularly example 2-5C. Applicant contends that these unexpected, beneficial results distinguish applicant's invention from the disclosure of Gaglani and that this result would not be predicted by one of ordinary skill in the art based upon the disclosure of Gaglani.

Said arguments have been considered but are not found to be persuasive.

Concerning claims 1, 10 and the data set forth in the specification in Table 2, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). The examiner respectfully submits that applicant's arguments and objective evidence are not commensurate in scope with the claims 1 and 10. Experiments limited to stabilization of one compound, i.e. IPBC, are not commensurate in scope with the claims. There is no adequate basis for reasonably concluding that the great number and variety of haloalkynyl compounds included in the claims would be stabilized in the same manner as IPBC. Please also see MPEP 716.02(d) and In re Lindner, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the prima facie case of obviousness because there was "no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition.").

Therefore, the rejection is respectfully maintained.

Conclusion

Claims 1-3, 5-8, 10 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Cybillie Delacroix-Muirheid** whose telephone number is **571-272-0572**. The examiner can normally be reached on Mon-Thurs. from 8:30 to 6:00 as well as every other Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher Low**, can be reached on **571-272-0951**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CDM

Oct. 5, 2005


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